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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,736	05/01/2001	Dan Sanchez	155695-203	6102

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT PAPER NUMBER

3739

DATE MAILED: 12/17/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,736

Applicant(s)

SANCHEZ ET AL. *cd*

Examiner

Beverly M Flanagan

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 12, 2003 has been entered.

Information Disclosure Statement

The information disclosure statement filed November 5, 2003 has been made of record and the references cited therein have been considered by the examiner.

Election/Restrictions

Applicant's election of the invention of claims 1-4 and 8-14 in Paper No. 4, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 5-7 and 15-24 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.

An action on the merits to the elected invention follows hereinafter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 8-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 8 have been amended to recite the following: "said adapter being coupled to said ring without any fasteners." However, as clearly shown in Figure 2 and discussed at page 8, lines 7-20 of the specification, the adapter 36 is provided with an outer annular flange 40 that rests on and inner annular lip 42 of the ring 32, where such an arrangement is provided for ease of insertion and removal of the adapter 36 into the ring 32. The flange 40 and annular lip 42 constitute a "fastener", in that they join or attach the adapter 36 and the ring 32. Thus, applicant cannot insert the recitation of "without any fasteners" into claims 1 and 8, as the originally-filed specification and figures clearly show and describe a "fastener." However, in the interest of completeness of this Office action, the examiner has addressed applicant arguments regarding the "fastener" of the instant invention in the body of the rejections below.

As claims 2-4 and 9-14 depend from claims 1 and 8, respectively, they are likewise rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn (U.S. Patent No. 5,810,712).

In regard to claims 1 and 4, Dunn teaches an endoscope support comprised of a support arm 50 that connected to an adaptable support mount 24 on pivot body 12 (see Figure 3). Pivot body 12 is comprised of a pivot ball 18 and a pivot ball retaining ring 20 (see Figure 3). An endoscope adapter 14 includes an adapter cylinder 30 with an inner cylinder bore 34 that defines an adapter bore 36 to receive the endoscope (see Figures 1, 3 and 4). Endoscope adapter 14 also has a stop flange 40 and multiple fitting ribs 42 that allow it to couple to the pivot ball 18 and retaining ring 20 (see Figure 1). Figure 3 shows that support mount 24 functions as a first joint that attaches the support arm 50 to the retaining ring 20 (see Figure 3). Assuming *arguendo*, that the flange and annular lip of the instant invention do not constitute a fastener, since the flange 40 and fitting ribs 42 are of the same type of connection as the flange and annular

lip of the instant invention (i.e., a readily-removable friction fit), the ring 20 and adapter 14 of Dunn are similarly coupled together without any fasteners.

In regard to claim 2, the pivot ball 18 of Dunn functions as a second joint that couples the adapter 14 to the support arm. **In regard to claim 3**, the ring 20 of Dunn supports the adapter 14 and is coupled to both the pivot ball 18 and the support arm 50 (see Figure 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,810,712) in view of Wang et al., (U.S. Patent No. 5,907,664).

In regard to claims 8, 11 and 12, Dunn teaches an endoscope support comprised of a support arm 50 that connected to an adaptable support mount 24 on pivot body 12 (see Figure 3). Pivot body 12 is comprised of a pivot ball 18 and a pivot ball retaining ring 20 (see Figure 3). An endoscope adapter 14 includes an adapter cylinder 30 with an inner cylinder bore 34 that defines an adapter bore 36 to receive the endoscope (see Figures 1, 3 and 4). Endoscope adapter 14 also has a stop flange 40 and multiple fitting ribs 42 that allow it to couple to the pivot ball 18 and retaining ring 20 (see Figure 1). Figure 3 shows that support mount 24 functions as a first joint that

attaches the support arm 50 to the retaining ring 20 (see Figure 3). Assuming *arguendo*, that the flange and annular lip of the instant invention do not constitute a fastener, since the flange 40 and fitting ribs 42 are of the same type of connection and the flange and annular lip of the instant invention (i.e., a readily-removable friction fit), the ring 20 and adapter 14 of Dunn are similarly coupled together without any fasteners. Dunn discloses that the support arm 50 can be of any type and adaptable support mount 24 may be changed to correspond to the mating portion of the support arm chosen (see col. 7, lines 9-23). Wang et al. teach a robotic arm assembly 16 that attaches to an endoscope 18 (see Figure 1), to allow for foot-operated movement of the arm, and thus, the endoscope, by the surgeon, which allows for enhanced manipulation of the endoscope and enhanced viewing by the surgeon (see col. 1, lines 59-67 and col. 2, lines 1-12). Wang et al., thus demonstrate that robotic arm assemblies for moving a surgical instrument are well known in the art. Since Dunn discloses the use of any suitable support arm and since Wang et al. disclose an advantageous robotic arm assembly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to substitute the robotic arm assembly of Wang et al. for the support arm 50 of Dunn.

In regard to claim 9, the pivot ball 18 of Dunn functions as a second joint that couples the adapter 14 to the support arm. **In regard to claim 10**, the ring 20 of Dunn supports the adapter 14 and is coupled to both the pivot ball 18 and the support arm 50 (see Figure 3). **In regard to claim 13**, Wang et al. teach that the robotic arm assembly 16 is attached to an operating table 14 and has an end effector 32 (see Figure 1). **In**

regard to claim 14, Figure 1 of Wang et al. shows various linkages pivotally connected to each other to form the robotic arm assembly 16.

Conclusion


All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (703) 305-7202. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
